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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,950	02/06/2002	Robert Blake	1274-006N	4201
9629	7590	12/17/2004		
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER LE, THIEN MINH	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/071,950

Applicant(s)

BLAKE ET AL.

Examiner

Thien M. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **DETAILED ACTION**

The information disclosure statement filed on 4/23/2002 has been entered.

Claims 1-37 are presented for examination.

#### ***Specification***

Claim 19 is objected to because of the following informalities. Appropriate correction is respectfully required.

Claim 19, step (d)(2), line 2, the term "vstep" is a typo.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 5,525,789 (Rockstein et al. – 5,525,789; herein after referred as 'the 789 patent' ).

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Although the conflicting claims are not identical, they are not patentably distinct from each other because they essentially recite the same limitations.

Claim 1 is rejected in view of claim 1 of the '789 patent. Similar to the claimed invention, claim 1 of the '789 patent recites an automatic bar code symbol reading system, comprising: a hand-supportable housing; an object detection means; an activatable scan data producing means; a laser beam generating means; a means for directing said visible laser beam; a laser beam scanning means; a laser light detecting means; a means for automatically producing scan data indicative of said detected intensity; a control means; a means for automatically activating said activatable scan data producing means; a means for automatically deactivating said activatable scan data producing means; wherein each having functions in the manner as recited in claim 1.

As can be seen, the patent protections have been granted to the earlier filed application.

Similarly,

Claim 2 is rejected in view of claim 2 of the '789 patent in that both recite: wherein said "laser beam generating means comprises a laser diode".

Claim 3 is rejected in view of claim in view of claim 3 of the '789 patent in that they both recite: wherein the "bar code symbol has first and second envelope borders, and wherein said scan data processing means comprises means for detecting the first and second envelope borders of said bar code symbol, and means for decoding said detected bar code symbol".

Claim 4 is rejected in view of claim 5 of the '789 patent in that they both recite: wherein said " laser beam generating means is operated in a pulsed laser mode so as to generate a pulsed visible laser beam, which is directed through said light transmission aperture and repeatedly scanned across said scan field" and said bar code symbol on said detected object.

Regarding claim 5, see claim 6 of the '789 patent.

Regarding claim 6, see claim 7 of the '789 patent.

Regarding claim 7, see claim 8 of the '789 patent.

Regarding claim 8, see claim 9 of the '789 patent.

Regarding claim 9, see claim 10 of the '789 patent.

Regarding claim 10, see claim 11 of the '789 patent.

Regarding claim 11, see claim 12 of the '789 patent.

Regarding claim 12, see claim 13 of the '789 patent.

Regarding claim 13, see claims 5 and claim 13 of the '789 patent.

Regarding claim 14, see claim 14 of the '789 patent.

Regarding claim 15, see claim 15 of the '789 patent.

Regarding claim 16, see claim 16 of the '789 patent.

Regarding claim 17, see claim 18 of the '789 patent.

Regarding claim 18, see claim 20 of the '789 patent.

Regarding claim 19, see claim 21 of the '789 patent.

Regarding claim 20, see claim 21 of the '789 patent. It is noted that claim 21 of the '789 patent recites a laser light source in lines 14-18.

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Regarding claim 21, see claim 23 of the '789 patent.

Regarding claim 22, see claim 24 of the '789 patent.

Regarding claim 23, see claim 25 of the '789 patent.

Regarding claim 24, see claim 26 of the '789 patent.

Regarding claim 25, see claim 27 of the '789 patent.

Regarding claim 26, see claim 28 of the '789 patent.

Regarding claim 27, see claim 29 of the '789 patent.

Regarding claim 28, see claim 30 of the '789 patent.

Regarding claim 29, see claim 31 of the '789 patent.

Regarding claim 30, see claim 32 of the '789 patent.

Regarding claim 31, see claims 32 and 33 of the '789 patent.

Regarding claim 32, see claim 34 of the '789 patent.

Regarding claim 33, see claim 35 of the '789 patent.

Regarding claim 34, see claim 36 of the '789 patent.

Regarding claim 35, see claim 37 of the '789 patent.

Regarding claim 36, see claim 38 of the '789 patent.

Regarding claim 37, see claim 39 of the '789 patent.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-

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2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Le, Thien Minh**  
**Primary Examiner**  
**Art Unit 2876**  
**December 6, 2004**